

REMARKS

No claims have been amended, added, or deleted. Hence, claims 1, 6, 16, 26, 29, 30, and 32 – 38 are pending in the application.

Summary of the Office Action

1. Claims 1, 16, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Samuels (U.S. Patent No. 5,270,821) in view of Ike (U.S. Patent No. 5,153,765) and Rosenberg (U.S. Patent No. 6,429,846) and Kawasaki (U.S. Patent No. 5,703,616).
2. Claims 6 and 26 are rejected under 103(a) as being unpatentable over Samuels in view of Ike and Rosenberg and Kawasaki as applied to claims 1 and 16, and further in view of Carroll. (U.S. Patent No. 6,121,960).
3. Claims 32 - 35 are rejected under 103(a) as being unpatentable over Samuels in view of Ike, Rosenberg, Kawasaki, and Carroll.
4. Claim 36 is rejected under 103(a) as being unpatentable over Samuels in view of Rosenberg and Kawasaki as applied to claim 36.
5. Claims 6 and 26 are rejected under 103(a) as being unpatentable over Samuels in view of Ike and Rosenberg and Kawasaki, and further in view of Carroll.

Rejections under 103(a) are not valid because Rosenberg does not qualify as prior art.

All rejections under 103(a) rely on the allegation that Rosenberg is prior art. However, the Office Action has not and cannot show that Rosenberg is prior art for purposes of 103(a).

Rosenberg was published after the filing date of the present application, and therefore may only qualify as prior art under 102(e). To qualify as prior art under 102(e),

Rosenberg must, at minimum, have an effective filing date that precedes April 22, 1999, the filing date of the present application ("present filing date").

The actual filing date of Rosenberg is Jan. 19, 2000, which is after the present filing date. So, Rosenberg must rely on a parent application for an effective filing date.

In the face sheet of Rosenberg, the Related U.S. Application Data section lists Rosenberg as a CIP of U.S. Application No. 09/467,307, which is listed therein as a CIP of other patent applications. However, the reference to U.S. Application No. 09/467,307 appears to be an error because the PAIRS system does not list U.S. Application No. 09/467,307 as a child of any of the other patent applications. The proper reference appears to be U.S. Application No. 09/467,309 (309'), as listed in PAIRS.

Per PAIRS, Rosenberg claims priority only to 309'. The filing date of 309' is December 17, 1999, after the present filing date. The priority claim thus fails to provide an effective filing date for Rosenberg that is before the present filing date. Rosenberg cannot qualify as prior art.

Application 309' does claim priority to certain parent applications that may have filing dates before the present filing date (U.S. Patent Applications 09/156,802, 09/487,737, 09/253,132, and 09/102,281). Rosenberg does indicate that perhaps at a point during its prosecution a claim of priority was being made to not only 309' but also its certain parent applications. If it is assumed the Rosenberg also claimed priority to these parent applications in addition to 309', Rosenberg would nevertheless fail to have an effective date before the present filing date.

The rejections rely on cited passages in Rosenberg describing a PDA. (see Office Action, page 4, last paragraph). To use a priority claim of a patent reference as a basis for applying the corresponding priority date as the effective filing date of the patent

reference, an application to which the patent reference claims priority must include the teaching relied upon for rejecting the claims under 103(a). (MPEP 2136.03(IV))

Applicant has reviewed Application 309' and the certain parent applications to which 309' claims priority. None of these (including 309') contain anything in any way similar to the cited passages of Rosenberg or teach anything in anyway similar to what is taught in the cited passages. Thus, even if Rosenberg claims priority to 309' and its certain parent applications, the filing dates of the certain parent applications could not be used as the effective filing date for purposes of 103(a). The Rosenberg effective filing date thus fails to precede the present filing date.

Based on the foregoing, Rosenberg does not qualify as prior art for purposes of 103(a). Therefore, all rejections are invalid. Reconsideration and allowance of the present application is respectfully requested.

CONCLUSION

Accordingly, a Notice of Allowance is requested by Applicants. Should any issues preclude allowance of this application, Applicant urges the Examiner to telephone Applicants' attorney at (408) 414-1206. The Office is given permission to charge any unpaid fees to Applicants' deposit account (50-1302).

Respectfully submitted,

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